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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,917	04/14/2004	Zeljko Vesligaj	5730-001	6088

25184 7590 05/12/2006

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EXAMINER
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PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/823,917		VESLIGAJ, ZELJKO	
	<b>Examiner</b>		<b>Art Unit</b>	
	Sebastiano Passaniti		3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 16-18, 24 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 24 and 26-28 is/are allowed.
- 6) ☒ Claim(s) 16-18 and 29-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office action is responsive to communication received 04/25/2006 –  
Request for Continued Examination (RCE) and Amendment.

Claims 1-7, 16-18, 24 and 26-31 remain pending.

Following is an action on the MERITS:

#### ***Claim Rejections - 35 USC § 102 and 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that  
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 17, 29 and 30 STAND rejected under 35 U.S.C. 102(e) as being  
anticipated by Wright, as set forth in the last Office action, mailed 02/17/2006.

Claims 18 and 31 STAND rejected under 35 U.S.C. 103(a) as being  
unpatentable over Wright, as set forth in the last Office action, mailed 02/17/2006.

***Minor Claim Objections***

Claims 1 and 16 STAND objected to because of the following informalities:

As to claim 1, line 6, after "surface"(first occurrence), the term --outer-- should be inserted. In line 7, "striking" should read --initial impact-- .

As to claim 16, line 5, after "surface" (first occurrence), the term --outer-- should be inserted.

Appropriate correction is required.

***Allowable Subject Matter***

Claims 1-7, 24 and 26-28 STAND allowable over the prior art references of record. A complete statement of reasons for allowance will be provided at such time as this application is in condition for allowance.

***Response to Arguments***

In the arguments received 04/25/2006, the applicant contends that the prior art reference to Wright shows a front face with a recess and a resilient insert fitted within the recess and extending to the lower edge of the front face. The applicant further contends that the resilient portion of the Wright face initially strikes a golf ball, which is an arrangement that is opposite to the arrangement intended by the applicant, wherein the golf ball is struck by the non-resilient portion of the striking face and then the resilient section of the striking face.

In response to these arguments, it is noted that the "whereby" phrases added to both claims 16 and 29 do not structurally distinguish the claimed invention over Wright. Instead, this added language would appear to merely address the manner in which the

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golf ball is to be struck. It is noted that Wright discloses that the insert (100) is fitted within a recess portion that is located in the lower part of the club head. The insert includes a plane that is coplanar with the remainder of the ball-striking surface and further includes a lower edge that is aligned with the lower front edge of the club head. The portion directly above the insert material and below the top surface of the head is deemed to be a non-resilient ball-striking surface. Thus, the Wright device includes the claimed structure and is fully capable of first striking a golf ball with the non-resilient section of the ball-striking surface and subsequently striking the golf ball with the resilient portion of the ball-striking surface.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp  
May 10, 2006

  
**Sebastiano Passaniti**  
Primary Examiner